

Remarks

Claims 1-7, 11 and 12 have been rejected under 35 U.S.C. §251 as including an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. This rejection is respectfully traversed for the following reasons.

Initially, it is noted that the present reissue application was filed within two years of the issuance of the patent from which it is based. Therefore, the present reissue application can include claims that are broader in scope than those in the patent, albeit without recapturing subject matter previously surrendered.

Further, for there to be impermissible recapture, the three step test for recapture set forth in M.P.E.P. §1412.02 (I) must be applied. The first step is to determine whether there was broadening in any of the claims. The second step, should broadening be found in a claim, is to determine whether the broadening aspects of the claim relate to subject matter previously surrendered during the prosecution of the original application. The third step, should the broadening aspects of the claim relate to subject matter previously surrendered during prosecution of the original application, is to determine whether the claim is materially narrowed in other respects to compensate for the broadening in the area of surrender.

Regarding the first step, it is apparent that the amendment of claim 1 to change the recitation of “a focus control means for ... driving said moving means on the basis of the detection signal” to “a focus control means for driving said moving means ... on the basis of an output signal” is broadening.

Regarding the second step, it is noted that M.P.E.P. §1412 (I)(B) sets forth two sub-steps for determining whether the broadening aspects of the claim relate to subject matter previously surrendered during the prosecution of the original application. The first sub-step is to determine whether there was any surrender of subject matter made in the prosecution of the original application. The second sub-step, if there was a surrender of subject matter in the original application prosecution, is to determine whether any of the broadening of the reissue claims is in the area of the surrendered subject matter.

In the prosecution of the original application, it is noted that claims 20-33 were subject to a restriction requirement in an Office Action mailed April 3, 2000 that indicated that there were thirty-three species of the invention set forth in the specification. In a Response dated September

5, 2000, claims 20-33 were canceled and replaced with new claims 34-48. Further, the restriction requirement was traversed and it was argued that there were only five species of the invention set forth in the specification, and that claims 34-48 were directed to species 5. In the Office Action of September 22, 2000, the Examiner indicated that the traversal of the restriction requirement was correct and only five species of the invention were set forth in the specification. Further, the Examiner agreed that claims 34-48 were directed to species 5. Claims 34-48 were subsequently allowed without any amendments thereto.

In applying the first sub-step of the second step, it is noted that the claims in the application on which the present reissue application is based were directed to the species 5. Therefore, the claims in the present reissue application must be directed to species 5.

In applying the second sub-step of the second step, it is noted that the change from “a focus control means for ... driving said moving means on the basis of the detection signal” to “a focus control means for driving said moving means ... on the basis of an output signal” in claim 1 is a permissible broadening within the species. Further, although the rejection indicates that claim 27 provides evidence of impermissible recapture, it is noted that the focus condition detection means recited in amended claim 1 is different than the recitation of the focus condition detection means recited in claim 27. Therefore, it is submitted that this amendment does not amount to recapture according to the second sub-step of the second step. As a result, it is unnecessary to continue the analysis to the third step.

As detailed in the above discussion, it is apparent that the amendment to claim 1 does not amount to recapture. As a result, withdrawal of the rejection of claims 1-7, 11 and 12 under 35 U.S.C. §251 is respectfully requested.

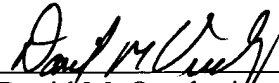
Claims 1-44 have been rejected under 35 U.S.C. §251 as lacking an appropriate defect. This rejection is traversed for the following reasons.

As discussed above, the present reissue application was filed within two years of the issuance of the patent from which it is based. Therefore, the present reissue application can include claims that are broader in scope than those in the patent, albeit without recapturing subject matter previously surrendered. Further, based on the above discussion, it is apparent that the amended and new claims set forth in the reissue application do not recapture subject matter previously surrendered. Therefore, the defect set forth in the Declaration is appropriate. As a result, withdrawal of the rejection of claims 1-44 under 35 U.S.C. §251 is respectfully requested.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. The Examiner is invited to contact the undersigned by telephone if it is felt that there are issues remaining which must be resolved before allowance of the application.

Respectfully submitted,

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